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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/816,820	03/22/2001	Hector Rodriguez	10990200-1	6153

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EXAMINER

TRAN, DOUGLAS Q

ART UNIT	PAPER NUMBER
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2624

DATE MAILED: 06/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/816,820	RODRIGUEZ, HECTOR	
	Examiner	Art Unit	
	Douglas Q. Tran	2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Amendment on 1/18/05.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4 is/are allowed.
- 6) ☒ Claim(s) 1-3,5,7-19,21 and 22 is/are rejected.
- 7) ☒ Claim(s) 6 and 20 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Tran

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-3, 5, 7-19, 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyamoto et al (US Patent No. 4,591,884) in view of the well known in the prior art .

As to claim 1, Miyamoto teaches a printing system comprising:

a printer (1 fig. 1); and

a first accessory device (i.e., a first paper handling portion 420 in fig. 16 or fig. 17)

coupled to receive printed pages from the printer, wherein the first accessory device contains a straight-through paper path (443 in fig. 16) and a reversing paper path (444 in fig. 16) to reverse the order of the printed pages received from the printer (col. 15, lines 30-49).

Although Miyamoto does not teach the accessory device externally couple to the printer, that limitation would be a design choice and well known in the prior art (i.e., some of prior art are attached with this office action in the Examiner Remark) because the accessory device should be a necessary device for the printer for receiving the printed paper from the print engine and outputting the printed paper to the user at the outputting trays. Therefore, the accessory device locates inside or outside the printer would be considered as a design choice.

It would have been obvious to modify the accessory device 420 of Miyamoto for externally couple to the printer as taught by the design choice and the well known in the printer

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art. The suggestion for modifying the accessory device 420 of Miyamoto can be reasoned by one of ordinary skill in the art because the printer system would increase the flexibility by connecting any necessary accessory device to the printer. Such a modification would allow to change or update the new accessory to the printer.

As to claim 2, Miyamoto discloses every feature discussed in claim 1, and further teaches the reversing paper path reverses the order of the printed pages received from the printer prior to processing the printed pages (col. 15, lines 30-49).

As to claim 3, Miyamoto discloses every feature discussed in claim 1, and further teaches the printer has an output coupled to the first accessory device, wherein the first accessory device receives printed pages from the printer output (col. 15, lines 30-49).

As to claim 5, Miyamoto discloses every feature discussed in claim , and further teaches the straight- through paper path maintains the printed pages in the same order as received from the printer (col. 15, lines 30-49).

As to claim 7, Miyamoto discloses every feature discussed in claim, and further teaches the first accessory device is a stapler (step of binding in fig. 30).

As to claim 8, Miyamoto discloses every feature discussed in claim, and further teaches the first accessory device is a binding device (step of binding in fig. 30).

As to claim 9, Miyamoto discloses every feature discussed in claim 1, and further teaches the first accessory device inserts additional media into the printed pages (col. 15, lines 30-49).

As to claim 10, Miyamoto discloses every feature discussed in claim 1, and further teaches the first accessory device is a hole punching device (step of binding in fig. 30).

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As to claim 11, Miyamoto discloses every feature discussed in claim, and further teaches the first accessory device is a mailbox device (429 in fig. 16) with multiple locations to receive printed sheets.

As to claim 12, Miyamoto discloses every feature discussed in claim 1, and further teaches wherein the printer is a laser printer (301 in fig. 1).

As to claim 13, Miyamoto discloses an accessory device (i.e., a first paper handling portion 420 in fig. 16 or fig. 17) capable of being coupled to receive printed pages from a previous device, the accessory device comprising:

a straight-through paper path (443 in fig. 16) that maintains the printed pages in the same order as received from the previous device; and

a reversing paper path (444 in fig. 16) to reverse the order of the printed pages received from the previous device (col. 15, lines 30-49).

Although Miyamoto does not teach the accessory device externally/removably couple to the printer, that limitation would be a design choice and well known in the prior art (i.e., some of prior art are attached with this office action in the Examiner Remark) because the accessory device should be a necessary device for the printer for receiving the printed paper from the print engine and outputting the printed paper to the user at the outputting trays. Therefore, the accessory device locates inside or outside the printer would be considered as a design choice.

It would have been obvious to modify the accessory device 420 of Miyamoto for externally couple to the printer as taught by the design choice and the well known in the printer art. The suggestion for modifying the accessory device 420 of Miyamoto can be reasoned by one of ordinary skill in the art because the printer system would increase the flexibility by

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connecting any necessary accessory device to the printer. Such a modification would allow to change or update the new accessory to the printer.

As to claim 14, Miyamoto teaches the reversing paper path reverses the order of the printed pages received from the previous device prior to processing the printed pages (col. 15, lines 30-49).

As to claim 15, Miyamoto teaches the accessory device is coupled to an output of the previous device to receive printed pages from the previous device (col. 15, lines 30-49).

As to claim 16, Miyamoto teaches including an output capable of being coupled to a second accessory device to allow the second accessory device to receive printed pages from the accessory device (col. 15, lines 30-49).

As to claim 17, Although Miyamoto does not teach the accessory device is configured to be coupled externally to a printing device and be configured as part of a chain of accessory devices that can be coupled together, that limitation would be a design choice and well known in the prior art (i.e., some of prior art are attached with this office action in the Examiner Remark) because the accessory devices in the series should be necessary devices for the printer for receiving the printed paper from the print engine and outputting the printed paper to the user at the outputting trays. Therefore, the accessory devices locate inside or outside the printer would be considered as a design choice.

It would have been obvious to modify the accessory device 420 of Miyamoto would be one of accessory devices in the series for externally couple to the printer as taught by the design choice and the well known in the printer art. The suggestion for modifying the accessory device 420 of Miyamoto can be reasoned by one of ordinary skill in the art because the printer system

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would increase the flexibility by connecting one or more necessary accessory devices. Such a modification would allow to change or update the new accessory devices to the printer.

As to claim 18, Miyamoto teaches a method comprising:

generating a plurality of printed pages from a printing device (3 in fig. 16);

outputting the plurality of printed pages, in reverse order, from the printing device to a first accessory device (i.e., a first paper handling portion 420 in fig. 16 or fig. 17) coupled to the printing device;

processing the received printed pages in the first accessory device (i.e., a first paper handling portion 420 in fig. 16 or fig. 17), wherein the first accessory device has a straight-through paper path (443 in fig. 16) that maintains the printed pages in the same order as received from the printing device and a reversing paper path (444 in fig. 16) to reverse the order of the printed pages received from the printing device (col. 15, lines 30-49).

Although Miyamoto does not teach the accessory device externally couple to the printer, that limitation would be a design choice and well known in the prior art (i.e., some of prior art are attached with this office action in the Examiner Remark) because the accessory device should be a necessary device for the printer for receiving the printed paper from the print engine and outputting the printed paper to the user at the outputting trays. Therefore, the accessory device locates inside or outside the printer would be considered as a design choice.

It would have been obvious to modify the accessory device 420 of Miyamoto for externally couple to the printer as taught by the design choice and the well known in the printer art. The suggestion for modifying the accessory device 420 of Miyamoto can be reasoned by one of ordinary skill in the art because the printer system would increase the flexibility by

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connecting any necessary accessory device to the printer. Such a modification would allow to change or update the new accessory to the printer.

As to claim 19, Miyamoto teaches including outputting the plurality of printed pages from the first accessory device to a second accessory device coupled to the first accessory device (col. 15, lines 30-49).

As to claim 21, Miyamoto teaches including communicating processing instructions from the printing device to the first accessory device (col. 15, lines 30-49).

As to claim 22, Miyamoto teaches the instructions determine whether the first accessory device is required to process the printed Pages (col. 15, lines 30-49).

Allowable Subject Matter

3. Claim 4 is allowed; and
4. Claims 6 and 20 are objected to as being dependent upon a rejected base claims 1 and 18 respectively, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

5. Applicant's arguments filed 01/18/05 have been fully considered but they are not persuasive.

Applicant argued in pages 7 and 9 to the amended independent claims 1 and 18 that: the accessory device is externally coupled to the printer and configured to receive printed pages from

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the printer; and argued in page 8 to the amended independent claim 13 that: the accessory device can be removably coupled to a previous device or other device. The argument has been fully considered but is not deemed to be persuasive because the limitation of "a previous device" from claim 13 which is considered by the Examiner as a printer; and although Miyamoto does not teach the accessory device externally couple to the printer, that limitation would be a design choice and well known in the prior art (i.e., some of prior art are attached with this office action in the Examiner Remark) because the accessory device should be a necessary device for the printer for receiving the printed paper from the print engine and outputting the printed paper to the user at the outputting trays. Therefore, the accessory device locates inside or outside the printer would be considered as a design choice.

For the above reasons, it is believed that the cited prior art fully discloses the claimed invention and the rejection stand.

Conclusion

Applicant's amendment with respect to independent claims 5-9 have been considered but are moot in view of the new ground(s) of rejection. This action is made **final**.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Examiner's Remark

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Salgado et al. (US Patent No. 5,898,592) discloses mailbox refer to temporarily or permanently assigning a unique and predetermined electronic address to respective ones of plural bins of sorter-like equipment for a printer.

Fujii et al. (US Patent No. 5,905,520) discloses a paper handling apparatus allows printed paper to be stacked efficiently.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Douglas Q. Tran whose telephone number is (703) 305-4857 or E-mail address is douglas.tran@uspto.gov.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-4700.

Douglas Q. Tran
June 10, 2005

